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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,406	11/29/2001	Thomas E. Macken JR.	G07.001/U	2385
28062	7590	12/27/2005	EXAMINER	
BUCKLEY, MASCHOFF, TALWALKAR LLC 5 ELM STREET NEW CANAAN, CT 06840			KRISCIUNAS, LINDA MARY	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/997,406	MACKEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Linda Krisciunas	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/13/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "adapted to" in claim 17 is a relative term which renders the claim indefinite. The term "adapted to" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Robertson et al (US 2002/0138320).

As per claim 1, 13, 15, 18 and 19 Robertson teaches receiving, via a process migration template (paragraph 35: "project template"), information associated with a process performed at a first location (paragraph 34: "located in at least two geographically remote locations"); determining at least one adaptation to the process to facilitate performance of the adapted process at a second location (paragraph 35: work item is processed in item (106)); and arranging for the adapted process to be performed at the second location (paragraph 36: "the processed work item is outputted via a process interface utilizing the network. Note operation (108).").

As per claim 2, Robertson teaches the process comprises one of: (i) a business process, (ii) accounting process, (iii) telephone call center process, (iv) human resource process (paragraph 29: the business process limitation is met by the items production and design (151), buying (152), and logistics (153)).

As per claim 3, Robertson teaches the first location and second location comprises one of: (i) a company, (ii) department, (iii) region (iv) country (paragraph 34: "any type of business may be involved" meets the limitation of company).

As per claim 4, Robertson teaches receiving is performed via a plurality of process migration templates (paragraph 35: "the project template includes a plurality of process templates").

As per claim 5, Robertson teaches receiving is performed via at least one of: (i) personal computer, (ii) portable computer, (iii) server (paragraph 39: workstation meets the limitation of personal computer).

As per claim 6, Robertson teaches receiving is performed via at least one of: (i) communication network, (ii) internet protocol network, (iii) internet, (iv) public network, (v) proprietary network (vi) wireless network (paragraph 39: communication network (235) meets the first limitation).

As per claim 7, Robertson teaches receiving information from a plurality of customer employees (paragraph 33: (102) "a work item is generated that is representative of communications between businesses utilizing a network").

As per claim 8, Robertson teaches information associated with the process comprises at least one of: (i) customer information, (ii) contact information, (iii) process description, (iv) technology information, (v) human resource information, (vi) financial information, (vii) quality information, (viii) legal information, (ix) migration expectation information, (x) feasibility score, (xi) risk score, (xii) schedule information (paragraph 148: supply chain data meets the limitation of process description and technology information).

As per claim 9, Robertson teaches determining comprises: determining customer requirements associated with the process; presenting a potential solution to the customer, including at least one of: (i) potential options, (ii) risk information, (iii) mitigation information, (iv) cost information, (v) benefit information; and receiving an indication of approval from the customer (paragraph 519: economic exchange meets the limitation of cost information).

As per claim 10, Robertson teaches automatically generating at least one of: (i) questionnaire, (ii) project plan, (iii) letter of commitment, (iv) requisition (paragraph 498:

scheduling capabilities meets the limitations of project plan as it would be inherent that a project plan have scheduling information).

As per claim 11, Robertson teaches automatically generating at least one of: (i) tollgate information, (ii) project plan, (iii) communication plan, (iv) baseline process, (v) volume information, (vi) training record, (vii) performance tracking plan, (viii) site readiness checklist, (ix) risk contingency plan, (x) issue resolution plan, (xi) process monitoring information, (xii) service agreement (paragraph 321: "baseline schedule" meets the limitation of baseline process).

As per claim 12, Robertson teaches adaptation comprises one of: (i) adapted process input, (ii) adapted process output, (iii) adapted process function (paragraph 425: business documents are adapted to other systems and the adaptor is used to translate the language of the system).

As per claim 14, Robertson teaches determining whether or not the adapted process will be performed at the second location (See Figure 5C: the project template is selected and the processes are defined, resources are assigned and progress of the project is monitored).

As per claim 16, Robertson teaches the storage device further stores a process migration database (paragraph 155: the storage device may be a database. See also Figure 4b where the process migration data is being translated into other languages and stored on a storage device.).

As per claim 17, Robertson teaches a communication device coupled to the processor and adapted to communicate with at least one of: (i) user device, (ii) customer device, (iii) mitigation controller (communication adapter (234)).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following art also teaches about facilitating the migration of a process: "McHugh, Pricewaterhousecooper's Develop WMS Configuration Templates", PR Newswire, October 12, 1998, Budhiraja et al (US 2003/0140126), Hickey (US 2002/0138570), Majjasie et al (US 6,873,997), and Majjasie et al (US 2005/0135273).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Krisciunas whose telephone number is 571-272-6931. The examiner can normally be reached on Monday through Friday, 6:30 am to 3:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LMK

*LMK*  
*Dec 16, 2005*

  
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